

**REMARKS**

Claims 1, 3-29, 31 and 33 are pending in the patent application.

**1. THE 35 U.S.C. § 112, 1<sup>ST</sup> PARAGRAPH REJECTION**

Claims 8, 15, 23, 31 and 34-37 were rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph as failing to comply with the enablement requirement. This rejection is submitted to be overcome by the present amendments. Accordingly, Applicant requests withdrawal of the Examiner's 35 U.S.C. § 112, 1<sup>st</sup> paragraph rejection.

**2. THE 35 U.S.C. § 101 REJECTION**

The Examiner rejected claims 8, 15, 23, 31 and 34-37 under 35 U.S.C. § 101 "because the disclosed invention is inoperative and therefore lacks utility." This rejection is submitted to be overcome by the present amendments. Accordingly, Applicant requests withdrawal of the Examiner's 35 U.S.C. § 101 rejection.

**3. THE 35 U.S.C. § 102 REJECTION OVER INNOUE**

In the "Response to Arguments" portion of the Office Action dated November 29, 2005, the Examiner stated on page 2 that "the '881 reference was properly used in the 102 and 103 rejections of the last office action" and that "[t]he previous rejections are maintained." Specifically, claims 1, 3, 4, 8-11, 15-19, 23-27 and 31-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by **Inoue** (U.S. Pat. No. 5,752,881).

This rejection is submitted to be overcome by the present amendments. Under the law of anticipation, "[f]or a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added). "The identical

invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

**Inoue** does not teach (or suggest), for example, a reel “comprising a reel strip bearing a plurality of discrete symbols and a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are thematically unified by the graphical element” (claim 1), a reel “comprising a reel strip bearing a plurality of discrete symbol positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are thematically unified by the graphical element” and “bearing a discrete symbol in at least one of said discrete symbol positions” (claim 9) or a reel “comprising a reel strip bearing a plurality of discrete symbols and a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are thematically unified by the graphical element” (claim 18).

**Inoue** also does not teach (or suggest), for example, “rotating a video reel, the video reel bearing a plurality of discrete symbol positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are thematically unified by the graphical element” and “moving a discrete symbol between the adjacent ones of the discrete symbol positions as the video reel is rotated.” (claim 25)

**Inoue**’s teaching of a reel (*e.g.*, 6) comprising an outer reel (*e.g.*, 17) and an inner reel (*e.g.*, 18), as shown in FIG. 2, is factually insufficient to anticipate the independent claims 1, 9, 18 and 25, or claims depending therefrom.

It is therefore submitted that claims 1, 3, 4, 8-11, 15-19, 23-27, and 31-33 are not anticipated under 35 U.S.C. § 102 by (or obvious over) **Inoue**. Reconsideration and withdrawal of this rejection is requested.

**4. THE 35 U.S.C. § 103 REJECTION OVER DAVIES AND WALKER**

Claims 1-4, 7-11, 14-19, 22-27 and 30-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Davies** (GB 2 330 936) in view of **Walker et al.** (U.S. 6,095,921) (hereinafter “**Walker**”). This rejection is respectfully traversed.

The Examiner alleges **Davies** discloses all of the elements of claim 1, but acknowledges that **Davies** does not teach a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element. **Walker** is relied upon for a teaching of a continuous graphical element (*citing* FIGS. 4B-C). The Examiner asserts that the combination of the device of **Davies** with the alleged continuous graphical element **Walker** would have been obvious at the time of the invention to one of ordinary skill in the art. This combination would yield, according to the Examiner, “a slot machine with the continuous graphical element on the inner band and a plurality of discrete symbols on the outer band” which would “allow the reel to rotate the continuous graphical element at a first velocity and the symbols at a second velocity.” The Examiner further asserts that the continuous graphical element would cover the entire width of the inner band (*citing* **Walker**, FIGS. 4B-C) extending between and visually unifying the symbols (*citing* **Walker**, FIG. 4A). This combination would purportedly “stimulate players’ interest in the game by providing a visual contrast by having an inner band with a continuous background (graphical element), and a transparent outer band with symbols superimposed over the background.” The continuous background is asserted to “provide an appealing contrast without interfering with the player’s ability to clearly see the symbols.”

**A. ALL ELEMENTS NOT TAUGHT OR SUGGESTED**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)(*stating* “[w]hen evaluating the scope of a claim, every limitation in the claim must be considered”).

The cited portion of **Walker** teaches that the conventional symbols have been *replaced* with an indicium 418 representing a visual continuum of values, in this case, width, such that an infinite number of positions may be represented by the reel (col. 6, lines 11-25). As shown in FIG. 6, the value displayed in reel width display 208 indicates the width of reel strip 132 at the point at which it intersects payline 235. The value displayed in total width display 214 is the total width of all three reel strips and indicates the outcome of the slot play (*e.g.*, a total width of 2.950 inches corresponds to a payout of ten coins for each coin wagered) (col. 8, lines 10-18). The indicium 418 of **Walker** does not extend between adjacent discrete symbols and, instead, replaces symbols entirely. Moreover, even in the context of the claimed combination, the indicium 418 of **Walker** would not “unify” the discrete symbols or discrete symbol positions borne by the reel. In other words, the indicium 418 of **Walker** is not a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are thematically unified by the graphical element (*e.g.*, claim 1, *see also* claim 18), or a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are thematically unified by the graphical element (*e.g.*, claim 9, *see also* claim 25).

**Davies** is unable to make up for the deficiencies of **Walker**. **Davies** teaches a reel comprising an outer reel (*e.g.*, 2) and an inner reel (*e.g.*, 1), as shown in FIG. 1. The assembly has “two symbol-bearing endless bands one within the other and movable around their own loops, the outer one having a transparency that makes the portion presented to the player, *when movement ceases*, display an overlay of one symbol over another” (col. 2, lines 4-8)(emphasis added). **Davies** teaches that “the outer, transparent reel band will have opaque numbers, letters or symbols on it that will generally not completely mask the symbols on the inner reel band” so that “[t]he player may see on the win line, for example, a bunch of cherries overlaid by the numeral 7” (page 3, lines 3-7).

**Davies** and **Walker** fail to teach or suggest a reel “comprising a reel strip bearing a plurality of discrete symbols and a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are thematically unified by the graphical element” (claim 1) or a reel “comprising a reel strip bearing a plurality of discrete symbol positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are thematically unified by the graphical element” and “bearing a discrete symbol in at least one of said discrete symbol positions” (claim 9). **Davies** and **Walker** fail to teach or suggest a reel “comprising a reel strip bearing a plurality of discrete symbols and a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are thematically unified by the graphical element” (claim 18). **Davies** and **Walker** also fail to teach or suggest “rotating a video reel, the video reel bearing a plurality of discrete symbol positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are thematically unified by the graphical element” and “moving a

discrete symbol between the adjacent ones of the discrete symbol positions as the video reel is rotated.” (claim 25).

Not only must every limitation of the claim be evaluated in ascertaining the proper scope of the claim, but claims must also be read as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 218 USPQ (Fed. Cir. 1983). The claimed continuous graphical element must thematically unify the discrete symbols or discrete symbol positions, not merely provide visual contrast therefore (*i.e.*, “The advantage of this combination would be to stimulate players’ interest in the game by providing a visual contrast” (page 11, numbered paragraph 25 of Office Action)). Examples of the claimed continuous graphical element are disclosed, for example, in FIGS. 3-8 of Applicant’s application. FIGS. 3-6 shows “a plurality of discrete symbols 60 and a continuous graphical element 62 extending between adjacent ones of the discrete symbols 60 such that the discrete symbols 60 are unified by the graphical element 62” (see par. [0014] of application). FIG. 7 shows another example of a continuous graphical element 70 formed by a plurality of spaces generally representative of a Monopoly™ board. FIG. 8 shows that, during the token race, each token 72 moves along the continuous graphical element 70 (*e.g.*, Monopoly board path), between adjacent ones of the discrete Monopoly board spaces, as the associated reel is rotated. The “broadest reasonable interpretation” of the claims permitted by law must be consistent with “the interpretation that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In this vein, “[c]laims are not to be read in a vacuum, and limitations therein *are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’*.<sup>1</sup>” *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983)(italics added).

Reconsideration and withdrawal of this obviousness rejection of claims 1-4, 7-11, 14-19, 22-27 and 30-37 over **Davies** and **Walker** is requested at least upon the above-stated ground.

**B. PROFFERED MOTIVATION TO MODIFY DAVIES IS LEGALLY INSUFFICIENT**

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. *See, e.g., Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Instead, “[t]he prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” That which is or may be within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980).

Indeed, it is well settled that there must be some motivation that would have led one of ordinary skill in the art to combine references or modify references to arrive at the claimed invention. *See, e.g., B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *Al-site Corp. v. VSI Int’l Inc*, 174 F.3d 1308 (Fed. Cir. 1999); *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). Thus, although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); *In re Fritch*, 972 F.2d at 1260 (Fed. Cir. 1992)).

The Examiner must show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the showing must be clear and

particular. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). Broad conclusory statements, standing alone, are not “evidence” supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

“The factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). It must be based on objective evidence of record. *In re Sang-Su Lee*, 277 F.3d 1338, 1345-46 (Fed. Cir. 2001); see also *In re Thrift*, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002). “A showing of a suggestion, teaching, or motivation to combine the prior art reference is an ‘essential component of an obviousness holding’” *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000); quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). The need for specificity pervades this authority. *In re Sang-Su Lee, supra, citing In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000)(“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”). The factual question of motivation is material to patentability cannot be dispensed with by a generalized assertion. In *In re Sang-Su Lee, supra*, the court admonished the Board of Patent Appeals and Interferences for failing to perform a “thorough and searching” factual inquiry in its reliance on the Examiner’s “conclusory statements,” emphasized that “determination of patentability must be based on evidence,” and stated that the board “cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims.”

In view of this overwhelming precedent setting forth the evidentiary requirements for setting forth a *prima facie* case of obviousness under 35 U.S.C. § 103(a), it is respectfully

submitted that the Examiner's stated motivation for combination of the references (*i.e.*, “[t]he continuous background would provide an appealing contrast without interfering with the players' ability to clearly see the symbols”) is conclusory and fails to satisfy the evidentiary requirements required to establish a *prima facie* case of obviousness. There appears to be absolutely no teaching or suggestion in either **Davies** or in **Walker** to “improve contrast” or make a more “appealing” contrast. Neither **Davies** nor **Walker** raises contrast as an issue. Moreover, the Examiner has failed to show that **Davies** or **Walker** teach or suggest reasons why a skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the element from **Walker** for combination with the elements of **Davies** in the manner claimed. There is simply no cognizable suggestion or motivation in either reference to make the proffered combination.

The legal concept of *prima facie* obviousness is a procedural tool of patent examination, allocating the burdens of going forward with production of evidence in each step of the examination process (*citations omitted*) (*see, e.g.*, MPEP § 2142). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. “If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker* 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Withdrawal of this rejection and allowance of claims 1-4, 7-11, 14-19, 22-27 and 30-37 is therefore requested for at least this reason.

### C. THE REFERENCES FAIL TO SUGGEST “INVENTION AS A WHOLE”

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*,

713 F.2d 1530 (Fed. Cir. 1983). Distilling the invention down to the “gist” of an invention disregards the requirement of analyzing the subject matter “as a whole.”

“[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” *In re Sponnoble*, 405 F.2d 578, 585 (CCPA 1969).

The rejected claims relate to a wagering game machine which, for example (*see* numbered paragraph [0014]), has reels with a plurality of discrete symbols 60 and a continuous graphical element 62 extending between adjacent ones of the discrete symbols 60 such that the discrete symbols 60 are thematically unified by the graphical element 62. The only teaching of this combination of elements is found within the Applicant’s disclosure. Both **Davies** and **Walker** appear devoid of any mention of such unification of discrete symbols by a graphical element. Any reliance on the Applicant’s disclosure to support the rejection is improper. “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (*see also In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)).

The rejection therefore fails, on its face, to provide a showing that the invention is taught or suggested by **Davies** or **Walker** and the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999).

Moreover, the Examiner has acknowledged that “Figs. 4B and 4C of Walker *do not* thematically unify the discrete symbols” (page 5 of Final Office Action)(emphasis added).

It is therefore submitted that the Examiner's burden to set forth a *prima facie* case of obviousness has not been discharged for at least this reason. Reconsideration and withdrawal of this obviousness rejection of claims 1-4, 7-11, 14-19, 22-27 and 30-37 over **Davies** and **Walker** is requested at least upon this ground.

#### **5. THE 35 U.S.C. § 103 REJECTION OVER DAVIES, WALKER AND DEMAR**

Claims 5-6, 12-13, 20-21 and 28-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Davies** in view of **Walker** and **Demar** et al. (U.S. 6,203,429) (hereinafter “**Demar**”). This rejection is respectfully traversed.

Claims 5-6, 12-13, 20-21 and 28-29 are asserted to be patentable over the combination of **Davies**, **Walker** and **Demar** for at least the reasons set forth above and such remarks are applied herein, but are not replicated for brevity. In view of the above, **Davies** and **Walker** fail to teach or suggest each and every element of the invention of the base claims from which claims 5-6, 12-13, 20-21 and 28-29 depend and fail to teach or suggest the modification and/or combination proffered by the Examiner to arrive at these base claims. **Demar** has also not been shown to cure the deficiencies of **Davies** and **Walker**. Reconsideration and withdrawal of this obviousness rejection is requested at least upon the grounds presented above in numbered paragraph 4.

**Demar** is alleged by the Examiner to teach a “graphical element that is a train in the form of a game board path (300, Fig. 8; col. 12, Lines 29 to 34)” (*see* page 15, numbered paragraph 38 of Office Action). The Examiner concludes and alleges that “[i]t would be obvious to one of ordinary skill in the art to apply the trail of ‘429 to the combination of ‘936 and ‘921. . . . to enhance interest in the game by providing a consistent, predictable theme (in this case, a popular board game) for the continuous background” *Id.* However, there appears to be no teaching or suggestion, in any of **Davies**, **Walker** or **Demar**, of incorporating the board game 300 depicted

in **Demar** (*i.e.*, the asserted continuous graphical element) into a reel, let alone for the purpose of, for example, unifying a plurality of discrete symbols associated therewith.

The Examiner's suggestion that "[t]he trail of '429 can be thought of as a loop, since it can be cycled through multiple times" and conclusion therefrom that "[i]t would thus be natural to apply the trail of '429 to one of the bands of '936 as the bands of '936 repeat multiple times" finds no basis or support in any of **Davies**, **Walker** or **Demar**. What is characterized by the Examiner as "natural" is anything but natural and has not been shown to be taught or suggested by any of the applied references.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, *guided only by the prior art references and the then-accepted wisdom in the field*. *See In re Dembiczaik*, 175 F.3d at 999, 50 USPQ2d at 1617. Applicant submits that the ease with which the Examiner arrives at the combination of elements, without any supporting suggestion for such modifications and combinations from the very references cited, is evidence that the Examiner failed to closely adhere to this methodology. The only teaching of this combination is found within the Applicant's disclosure. Any reliance on the Applicant's disclosure to support the rejection is improper. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (*see also In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) stating "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure."). *See also W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Applicant submits that the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. § 103 for at least this reason. Withdrawal of this 35 U.S.C. § 103 rejection over the combination of **Davies, Walker and Demar** is therefore requested.

#### **6. THE 35 U.S.C. § 103 REJECTION OVER INNOUE**

In the “Response to Arguments” portion of the Office Action dated November 29, 2005, the Examiner stated on page 2 that “the ‘881 reference was properly used in the 102 and 103 rejections of the last office action” and that “[t]he previous rejections are maintained.” Specifically, claims 5-7, 12-14, 20-22 and 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Inoue**. This rejection is traversed.

##### **A. PROFFERED MOTIVATION TO MODIFY INOUE INSUFFICIENT**

As to claims 5, 6, 12, 13, 20, 21, 28 and 29, the Examiner alleges that it would have been “an obvious design choice to one of ordinary skill in this art to provide a particular theme for a particular slot machine; in order to fulfill a customer’s preference or tastes or the like.” The Examiner further states that, “[a]bsent a showing of criticality, it is obvious to one of ordinary skill in the art to convert a stepper motor slot machine into a video slot machine” on the bases that “[b]oth are deemed art recognized equivalents in this art.”

The courts have upheld obviousness findings based on the doctrine of “obvious design choice” in cases such as *In re Japikse*,<sup>1</sup> wherein claims to a power press which read on the prior art except with regard to the position of the starting switch (held unpatentable because shifting the position of the starting switch would not have modified the operation of the device) and *In re Kuhle*,<sup>2</sup> (the particular placement of a contact in a conductivity measuring device was held to be

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<sup>1</sup> 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

<sup>2</sup> 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

an obvious matter of design choice). The courts have also cautioned, however, that “[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Instead, “[t]he prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.”

In this case, the claim elements at issue constitute elements that affect and form a part of a game play experience (*see, e.g.*, FIGS. 3-8 and corresponding disclosure). Thus, the trivial, non-functional modifications cited in *In re Japiske* and *In re Kuhle* can hardly be said to be comparable to the design effort that must be expended to design a wagering game, including considerations of divining, anticipating, and meeting a customer’s preference or tastes (*e.g.*, some players like video-based games, other players dislike video based games). Wagering game development is a time-consuming, difficult endeavor taking a great many people a very long time to invent, develop, and bring to market such products. It is accordingly submitted that the Examiner’s reliance on “obvious design choice” as a basis underpinning the 35 U.S.C. § 103 obviousness rejection is improper. The question of whether a claim limitation may be within the level of ordinary skill in the art, whether such assertion is explicit or implied, is not a sufficient basis for concluding that the claimed subject matter *would have been* obvious under 35 U.S.C. § 103. That which is or may be within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980). Indeed, it is well settled that there must be some motivation that would have led one of ordinary skill in the art to modify the prior art reference (in this case, **Inuoe**) to arrive at the claimed invention. *See, e.g., B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed.

Cir. 1996); *Al-site Corp. v. VSHnt 7 Inc.*, 174 F.3d 1308 (Fed. Cir. 1999); *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000).

#### B. INOUE FAILS TO TEACH OR SUGGEST EVERY ELEMENT OF CLAIMS

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka, supra*. As noted above, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson, supra*.

As noted above, **Inoue** does not teach or suggest each and every claim element. **Inoue**’s teaching of a reel (*e.g.*, 6) comprising an outer reel (*e.g.*, 17) and an inner reel (*e.g.*, 18), as shown in FIG. 2, is factually and legally insufficient to render obvious the independent claims 1, 9, 18 and 25, or claims depending therefrom (*i.e.*, here claims 5-7, 12-14, 20-22 and 27-30). For example, **Inoue** does not disclose or suggest a reel “comprising a reel strip bearing a plurality of discrete symbols and a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are thematically unified by the graphical element” (claims 1, 3-8, 18-24). **Inoue** also does not disclose or suggest a reel “comprising a reel strip bearing a plurality of discrete symbol positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are thematically unified by the graphical element, the reel also bearing a discrete symbol” (claims 9-17). Instead, as shown in FIG. 7, the graphical elements on reels 18, 22, and 23, displayed in positions 19a, 19b, and 19c behind discrete symbol positions centered in windows 3, 4 and 5, respectively, do not extend between adjacent ones of the discrete symbols *such that the discrete symbol positions are unified by the graphical element*. Thus, looking at the rightmost reel 8 in FIG. 7, the alleged continuous graphical element 19a does not extend between adjacent ones of the discrete symbols

(e.g., the BAR symbol(s) above and below) such that the discrete symbol positions (e.g., the BAR symbols and the “7” symbol) are thematically unified by the graphical element.

**Inoue** does not suggest, *as a whole*, thematic unification of the discrete symbols or of the discrete symbol positions in the manner claimed and disclosed by Applicant. In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983).

In view of the above, it is respectfully submitted that the Examiner has not set forth a *prima facie* case of obviousness for want of the requisite factual basis. The factual showing must be clear and particular. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *CR. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). It is submitted that the Examiner’s burden to set forth a *prima facie* case of obviousness has not been discharged

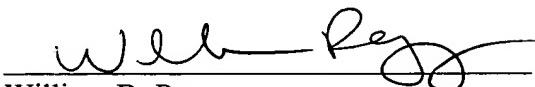
## 7. CONCLUSION

It is the Applicant’s belief that all of the claims are patentable and are in condition for allowance, and action towards that end is respectfully requested.

If the Examiner maintains any of the aforementioned rejections, Applicant respectfully requests identification of the reference(s) relied upon to support the Examiners contentions of teachings and suggestions that are asserted to be well-known (*see, e.g.*, MPEP § 2144.03; 37 C.F.R. § 1.104(c)(2); *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697). Applicant respectfully traverses these contentions.

No fees are believed necessary. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00119USPT.

Respectfully submitted,



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